

REMARKS

Applicant respectfully requests reconsideration of the claim rejections set forth in the Office communication dated March 22, 2007.

Summary

Claim 11 is currently amended.

Claim 17 is cancelled.

Claims 11 – 16 and 18 – 24 are pending.

Allowable Subject Matter

Claim 17 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections – 35 U.S.C. § 112, first paragraph

Claims 11 – 24 were rejected pursuant to 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 11 recites a method for verifying the authenticity of a coupon comprising, *inter alia*, providing, on or within the coupon, a first material having a lower starch content than non-currency grade paper forming the coupon.

The Examiner stated: “it remains unclear as to how much starch content is found in non-currency grade paper. This information is essential in determining how much starch content is found in the first material, based upon instant claim 11” (Office action dated March 22, 2007; page 7). Applicant respectfully disagrees. Claim 11 recites “providing, on or within the coupon, a first material having a lower starch content than non-currency grade paper forming the coupon.” This limitation establishes that the coupon paper has starch in two ways – non-currency grade paper and that the material has a lower starch content. As noted by U.S. Patent No. 5,063,163, currency grade paper does not include starch but other

papers do (col. 2, lines 4-14). Claim 11 does not require a specific amount of starch since it is the lower level of starch that is being claimed. That the coupon includes starch and that the first material has less starch is claimed. The amount of starch content of the non-currency grade paper is relative to the starch content of the first material. Thus, an exact amount of starch content is not needed. For example, if the starch content of the non-currency grade paper is “x” then the starch content of the first material is less than “x.” The claim language is definite. Claim 11 strikes a definite relationship between the amount of starch content of the non-currency grade paper and the starch content of the first material.

The Examiner also stated: “Neither the instant claims or specification teaches how much starch content is in non-currency grade paper, which makes it difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed” (Office action dated March 22, 2007; page 2). Applicant respectfully disagrees. Both the claims and specification teach the starch content of the non-currency grade paper is higher than the starch content of the first material. This clearly defines a structural difference between the first material and the non-currency grade paper. One skilled in the art can simply compare the starch content of non-currency grade paper to the starch content of the first material. Even if it were difficult to make this comparison, MPEP 2164.01 merely requires “the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” Applicant submits that determining whether the starch content of the first material is lower than the starch content of the coupon would not require undue experimentation for one skilled in the art.

The Examiner argues that not knowing the starch content of the non-currency grade paper “makes it difficult to determine a lower starch amount in the first material.” However, MPEP 2164.01 states that “the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.” Cited references 6,214,766 and 5,063,163 illustrate that it is common in the art to make a distinction between starch content in paper. For example, U.S. Patent No. 5,063,163 desires a reliable and simple way to detect paper currency as opposed to counterfeit paper made with a copying machine (col. 1, lines 12-15, and 29-33; and col. 2, lines 4-7). In recognition of

the relative difference between the starch content of non-currency grade paper and currency grade paper, a chemical test is proposed (col. 2, lines 4-14). To work, the teaching of U.S. Patent No. 5,063,163 relies on the well known difference in starch content between currency grade (“absence of starch”) and non-currency grade paper with starch. A person of ordinary skill in the art would understand the relative recital of “providing, on or within the coupon, a first material having a lower starch content than non-currency grade paper forming the coupon.” U.S. Patent No. 5,063,163 relies on this basic understanding to operate.

As another example, U.S. Patent No. 6,214,766 notes that starch is a common ingredient used during the papermaking process (col. 1, lines 10-15). “Substantial quantities of starch are routinely incorporated in the papermaking process” (col. 2, lines 26-28 and 58-60). While a specific starch content is not provided in U.S. Patent No. 6,214,766, the relative starch content is relied on for operation. Since claim 11 recites a relative starch content of non-currency grade paper to the material being provided, a person of ordinary skill in the art would understand claim 11.

Non-currency grade paper clearly includes substantial or detectable amounts of starch. A person of ordinary skill in the art knows non-currency grade paper includes starch, so would understand a material having lower starch content. Even if the determination is difficult, it is not undue because it is common in the art. MPEP 2164.01 also states that “the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue.” Applicant submits that the Examiner has not adequately set out that the comparison of starch content is undue.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 11 – 24 were rejected pursuant to 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 recites comparative starch content, not an absolute content. Therefore, claims 11 – 24 point out the claimed subject matter.

Claim Rejections

Claim 11 was amended to incorporate features recited in allowable claim 17. Therefore, claim 11 is allowable over the cited references for at least the same reasons that claim 17 is allowable over the cited references.

Dependent claims 12 – 16 and 18 – 19 depend from allowable claim 11, so are allowable for at least this reason.

Claim 20 was amended to include the limitation from claim 17. Even though claim 17 did not depend from claim 20, claim 20 is believed to be allowable for the same reasons.

Dependent claims 21 – 24 depend from allowable claim 20, so are allowable for at least this reason.

CONCLUSION

For at least the reasons presented above, the Applicants respectfully submit that the pending claims are in condition for allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

Craig A. Summerfield

Craig A. Summerfield
Registration No. 37,947
Agent for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200